UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/682,775	10/18/2001	Jason J. Harms	2290	4210

			EXAMINER
24333	7590	04/07/2006	VO, TED T

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ART UNIT	PAPER NUMBER
2191	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

		Application No.	Applicant(s)
		09/682,775	HARMS, JASON J.
Office Action Summary		Examiner	Art Unit
		Ted T. Vo	2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>23 November 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-32</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-32</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>18 October 2001</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some *   c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

1.   This action is in response to the amendment filed on 11/23/2005, entered by the filing RCE on

1/25/06.

Claims 1-32 are pending in the application.

Response to Arguments

2.   Applicant's arguments with respect to the amended claims filed on 11/23/2005 have been fully

considered.

With regards to the arguments relating to Claims 1-9, 17-32, particularly recited in the manners in Claims

1, 6, 17:

"A method for removing entry of a device from a computer system, said method comprising:

searching configuration data for an entry for a device with not properly identified by the system; and

removing the entry for the device from the configuration data"

In light of the specification, it should be noted that this type of claim covers a manual act; simply, a

computer user uses the **Microsoft standard Registry editor** and the manual act does:

Open the Enum registry key.

In Windows 2000 or XP, do the following:

Click the **plus sign (+)** next to HKEY_LOCAL_MACHINE.

Click the plus **plus sign (+)** next to SYSTEM.

Click the **plus sign (+)** next to CurrentControlSet.

Click the **plus sign (+)** next to Enum.

In Windows 95, 98, or Me do the following:

Click the **plus sign (+)** next to HKEY_LOCAL_MACHINE.

Click the **plus sign (+)** next to Enum.

Click the **plus sign (+)** next to a "DEVICE KEY ENTRY".

Detach/remove/or attach simply provided with Microsoft Windows Utility commands.

Another interpretation from the scope of the claim, this claim covers a manual act performed on a feature, add/remove programs, standardized in every Microsoft Windows. For example using Microsoft Windows control panel, double click on the icon showing "add/remove programs", search for an entry such as the name of an install program that fails to perform properly by the Windows, uncheck the box or position on the program, using detach/remove commands provided by with Microsoft Windows Utility.

A Claim cannot be **patentable over a common manual act**. Particularly, this act is operated under a trademark registered by Microsoft Windows. Applicants in the argument fail to identify their novelty features as required under MPEP 714.04.

With regards to the arguments relating to Claims 10-16, Claims recite programming instruction that replace a manual act such as the act mentioned above done by every computer user. It should be noted that,

> In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958) (Appellant argued that claims to a permanent mold casting apparatus for molding trunk pistons were allowable over the prior art because the claimed invention combined "old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed." **The court held that broadly providing an automatic or mechanical means to replace a manual activity** which **accomplished the same result** is **not sufficient** to distinguish over the prior art.). (Emphasis added)
> (See MPEP 2144.04)

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 18-26, 30, 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as the

invention.

Regarding Claims 18-26, it recites "An apparatus as claimed in claim...". It should be noted that using

"An apparatus" in a dependent claim would cause the claim insufficient antecedent basis.

Regarding Claim 30, it recites "A method a claimed in claim 6". It should be noted that using "A method"

in a dependent claim would cause the claim insufficient antecedent basis.

Regarding Claim 33, it recites "The computer readable medium of claim 13". This phase fails to match

with the system as claimed in the Claim 13.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for

the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed
publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6.   Claim 1-21, 23-32 are rejected under 35 U.S.C. 102(a) as being anticipated by an online

reference, last modified by http://www.targus.com/us/Downloads/USB_TR.pdf on 05/30/00 , "Windows

98 – UBS TROUBLESHOOTING REFERNCE" (hereinafter: Windows 98)

         Given the broadest reasonable interpretation of followed claims in light of the specification.

As per Claim 1: Windows 98 discloses,

A method for removing entry of a device from a computer system, said method comprising:

searching configuration data (shown as 'System Properties' or information in Registry editor) *for an entry*

for a device with not properly identified by the system

 (In p.1: see top paragraph: 'a USB device not being recognized', and see 'System Properties'); *and*

removing the entry for the device from the configuration data (Se p. 6, see 'Locate the key', and see 'hit Delete to remove the device node').

<u>As per Claim 2</u>: Windows 98 discloses, *The method of claim 1, further comprising: determining a vendor of the device;* (p.1, see 'System Properties': Intel 83271AB/...) *searching subkeys in the configuration data for all devices associated with the vendor; and deleting keys associated with the devices associated with the vendor* (See. P. 6. 'Locate the key', and 'hit Delete to remove the device node').

<u>As per Claim 3</u>: Windows 98 discloses, *The method of claim 1, further comprising: modifying an initialization file to remove device information* (Standard Windows requires configuration files or initialization files as a part of Window configuration system. These file are located under \window\...\, and a user can manually modify the text content of the files. See p. 2)

<u>As per Claim 4</u>: Windows 98 discloses, *The method of claim 1, further comprising: deleting files identified in a file list* (See page p.5, 'Registry Editor', right area of Registry Editor is a file list, and see last line in this page).

<u>As per Claim 5</u>: Windows 98 discloses, *The method of claim 4, wherein the deleting element further comprises: saving a backup copy of the files prior to deletion* (In the Windows 98, when open a file, simply double click on the file, Windows commands such as, SAVE, SAVE AS, provide save the file including it backup. When position on the file, Windows commands such as, DELETE, perform file deleting, The Windows discloses this claiming).

<u>As per Claim 6</u>: Regarding limitation of Claim 6, Windows 98, providing manual instructions as shown in the reference, and as set forth in the rationale discussed in the rejection of Claim 1, discloses the limitation of Claim 6 (and see associated text in the reference).

<u>As per Claim 7</u>: Regarding limitation of Claim 7, Windows 98, providing manual instructions as shown in the reference, and as set forth in the rationale discussed in the rejection of Claim 2, discloses the limitation of Claim 7 (and see associated text in the reference).

As per Claim 8: Regarding limitation of Claim 8, Windows 98, providing manual instructions as shown in the reference, and as set forth in the rationale discussed about modifying in the rejection of Claim 3, discloses the limitation of Claim 8 (and see associated text in the reference).

As per Claim 9: Regarding limitation of Claim 9, Windows 98, providing manual instructions as shown in the reference, and as set forth in the rationale discussed for modifying in the rejection of Claim 4, discloses the limitation of Claim 9 (and see associated text in the reference).

As per Claim 10: Regarding limitation of Claim 10, Windows 98, providing manual instructions as shown in the reference, and as set forth in the rationale discussed in the rejection of Claim 1, discloses the limitation of Claim 10 (and see associated text in the reference).

As per Claim 11: Regarding limitation of Claim 11, Windows 98, providing manual instructions as shown in the reference and as set forth in the rationale discussed in the rejection of Claim 2, discloses the limitation of Claim 11 (and see associated text in the reference).

As per Claim 12: Regarding limitation of Claim 12, Windows 98, providing manual instructions as shown in the reference and as set forth in the rationale discussed in the rejection of Claim 4, discloses the limitation of Claim 12 (and see associated text in the reference).

As per Claim 13: Regarding limitation of Claim 13, Windows 98 which is installed in a computer, as seen in the rationale discussed for modifying in the rejection of Claim 1, discloses the limitation of Claim 13, because a Windows requires storage to store it and a processor to execute it (and see associated text in the reference).

As per Claim 14: Regarding limitation of Claim 14, Windows 98, providing manual instructions as shown in the reference and as set forth in the rationale discussed in the rejection of Claim 2, discloses the limitation of Claim 14 (and see associated text in the reference).

As per Claim 15: Regarding limitation of Claim 15, Windows 98, providing manual instructions as shown in the reference and as set forth in the rationale discussed in the rejection of Claim 2, discloses the limitation of Claim 15 (and see associated text in the reference).

As per Claim 16: Regarding limitation of Claim 16, Windows 98, providing manual instructions as shown in the reference, and as set forth in the rationale discussed about modifying in the rejection of Claim 3, discloses the limitation of Claim 16 (and see associated text in the reference).

As per Claim 17: Regarding limitation of Claim 15, Windows 98, providing manual instructions as shown in the reference, and as seen in the rationale discussed for modifying in the rejection of Claim 1, discloses the limitation of Claim 17).

As per Claim 18: Regarding limitation of Claim 18, Windows 98, providing manual instructions as shown in the reference and as set forth in the rationale discussed in the rejection of Claim 2, discloses the limitation of Claim 18 (and see associated text in the reference).

As per Claim 19: Regarding limitation of Claim 19, it discloses Windows 98 files, see p.6, "HKEY_LOCAL_MACHINE\enum\...".

As per Claim 20: Regarding limitation of Claim 20, it discloses Windows 98 files, see p.2, "WINDOWS\SYSTEM32\...".

As per Claim 21: Regarding limitation of Claim 21, it discloses Windows 98 files, see p.6, "HKEY_LOCAL_MACHINE\enum\...".

As per Claim 23: Windows 98 discloses Registry editor that can perform removing means such as performed on an information storage medium and load on to a computer (see p. 5: Insert Disk, and p.6).

As per Claim 24: Windows 98 discloses Registry editor that can perform configuring means such as performed on an information storage medium and load on to a computer (see p. 5: Insert Disk, and see p.1, the steps).

As per Claim 25: Windows 98 discloses Registry editor that can perform configuring means such as performed on an information storage medium and load on to a computer (see p. 5: Insert Disk, and see p. 1, the steps).

As per Claim 26: Windows 98 discloses Registry editor that can perform modifying means such as performed on an information storage medium and load on to a computer (see p. 5: Insert Disk, and see p. 5, the text under "WHAT THE REGISTRY MAY LOOK LIKE").

As per Claim 27: Windows 98 discloses Registry editor and configuration that provides a manual act for

search (Refer: In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).

As per Claim 28: Windows 98 discloses Registry editor and configuration that provides a manual act for

search (Refer: In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)).

As per Claim 29: Windows 98 discloses,

 Where the device is considered to be not properly identified by the system when

 (i) not identified by the system,

 (ii) not completely recognized by the system, or

 (iii) only identified as a generic device by the system.,

See top paragraph in p. 1.

As per Claim 30: Claim 30 is indefinite as noted: For the limitation recited in claim 30: Windows 98

discloses this limitation. See top paragraph in p. 1.

As per Claim 31: See rationale in the rejection of Claim 29.

As per Claim 32: See rationale in the rejection of Claim 29.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness

rejections set forth in this Office action:

A person shall be entitled to a patent unless —

(a) A patent may not be obtained though the invention is not identically disclosed or described as
set forth in section 102 of this title, if the differences between the subject matter sought to be
patented and the prior art are such that the subject matter as a whole would have been obvious
at the time the invention was made to a person having ordinary skill in the art to which said
subject matter pertains. Patentability shall not be negatived by the manner in which the invention
was made.

8.   Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over an online reference, last

modified by www.targus.com/us/ on 05/30/00, "Windows 98 – UBS TROUBLESHOOTING REFERNCE"

(hereinafter: Windows 98) .

As per claim 22: Win.ini file is an element of WINDOWS 98 that has therein predetermined devices

used/associated with the Windows system registry.

Windows 98 does not explicitly shown in the WIN.INI the predetermined device such as : load=, run=,

device=lines, as claimed in the Claim 22.

       However these differences are only found in the nonfunctional descriptive material
and are not functionally involved in the steps/means recited. The predetermined device in
the WIN.INI in Microsoft Windows would be performed the same regardless of the type of
device data as claimed. Thus, this descriptive material will not distinguish the claimed
invention from the prior art in terms of patentability, see In re Gulack, 703 F.2d 1381, 1385,
217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir.
1994).

       Therefore, it would have been obvious to a person of ordinary skill in the art at the
time the invention was made to clear the data as shown in the claim 22 as the type of data
or information as for conforming to the uninstalled requirements of the Windows, and
because such data or information does not functionally relate to the steps in the method
claimed and because the subjective interpretation of the data does not patentably
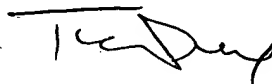distinguish the claimed invention.

Conclusion

9.   Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Ted T. Vo whose telephone number is (571) 272-3706. The examiner can normally be

reached on 8:00AM to 4:30PM.

       If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei

Y. Zhen can be reached on (571) 272-3708.

       The facsimile number for the organization where this application or proceeding is assigned is the

Central Facsimile number **571-273-8300**.

Any inquiry of a general nature or relating to the status of this application should be directed to

the TC 2100 Group receptionist: 571-272-2100. Information regarding the status of an application may

be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status information for

unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ted T. Vo
Primary Examiner
Art Unit 2191
March 31, 2006